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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/753,537	01/02/2001	David L. Multer	FUSN1-01003US0	1714
28554	7590	11/22/2004	EXAMINER	
VIERRA MAGEN MARCUS HARMON & DENIRO LLP			RONES, CHARLES	
685 MARKET STREET, SUITE 540			ART UNIT	
SAN FRANCISCO, CA 94105			PAPER NUMBER	
			2164	

DATE MAILED: 11/22/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/753,537

Applicant(s)

MULTER ET AL.

Examiner

Charles Rones

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 07 June 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 80-116 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 80-83 and 88-116 is/are rejected.
- 7) ☐ Claim(s) 84-87 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 02 January 2001 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. §§ 119 and 120

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 13) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.
- a) ☐ The translation of the foreign language provisional application has been received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 2/02, 6/04.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other:

## **DETAILED ACTION**

### ***Amendment***

The amendment timely filed on June 7, 2004 has been entered.

### ***Drawings***

New corrected drawings in compliance with 37 CFR 1.121(d) are required in this application because some of the shading in the figures obscure the words. Applicant is advised to employ the services of a competent patent draftsman outside the Office, as the U.S. Patent and Trademark Office no longer prepares new drawings. The corrected drawings are required in reply to the Office action to avoid abandonment of the application. The requirement for corrected drawings will not be held in abeyance.

### ***Double Patenting***

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 80-116 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-79 of copending Application No. 09/753,537 in view of 09/ 753,643.

Claims 80-116 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-79 of copending Application No. 09/753,537 in view of 09/ 753,644.

Although the claim wording is not the same, the metes and limitations are have only slight differences, which are arguably broader than those in the present application.

This is a provisional obviousness-type double patenting rejection.

### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 80-83, 88-104 and 106-116 are rejected under 35 U.S.C. 102(b) as being anticipated by Morris U.S. Patent No. 5,574,906 ('Morris').

**Morris** discloses:

As to claim 80,

computer code for comparing at least one file on the personal computer and a record of the file on the computer, and providing binary differencing data between the file and the record of the file; See Abstract; 11:52-67; 12:1-15; and

a transaction generator providing at least one binary difference transaction including said binary differencing data to an output; See Abstract; 11:52-67; 12:1-15.

As to claim 81,

wherein the output is coupled to a network, and the synchronizer is operatively coupled to at least one storage server via the network, the storage server receiving said difference transaction from said synchronizer; See Abstract; 11:52-67; 12:1-15.

As to claim 82,

wherein the synchronizer receives at least one binary difference transaction from the storage server, and further including computer code for applying the received difference transaction to the at least one file on the device; See Abstract; 11:52-67; 12:1-15.

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As to claim 83,

wherein the synchronizer includes code for updating the record of the file on the device subsequent to applying the received difference transaction; See Abstract; 11:52-67; 12:1-15.

As to claim 90,

wherein the computer code for comparing at least one file on the personal computer includes Xdelta; See Abstract; 11:52-67; 12:1-15.

As to claim 91,

an application data access routine; See Abstract; 11:52-67; 12:1-15;

a differencing transaction generator including binary difference data extractor;

See 11:1-64;

a user interface; See Abstract; 11:52-67; 12:1-15; and

a network transfer routine; See Abstract; 11:52-67; 12:1-15.

As to claim 92,

wherein the nonvolatile storage apparatus is a local storage device in a computer; See Abstract; 11:52-67; 12:1-15.

As to claim 93,

wherein the nonvolatile storage apparatus comprises a network storage apparatus; See Abstract; 11:52-67; 12:1-15.

As to claim 94,

wherein the computer code is provided in an installation package further including an installation routine; See Abstract; 11:52-67; 12:1-15.

As to claim 95,

wherein the differencing transaction generator determined difference data based on comparing at least one file to a record of said at least one file; See Abstract; 11:52-67; 12:1-15.

As to claim 96,

wherein the differencing transaction generator outputs instructions to add, delete or modify the file based on the difference data extracted; See Abstract; 11:52-67; 12:1-15.

As to claim 97,

wherein the binary difference data extractor comprises Xdelta; See Abstract; 11:52-67; 12:1-15.

As to claims 88, 98, and 103,

an encryption routine encrypting the difference transaction; See 2:24-29; 10:35-39.

As to claims 89, 99, and 104,

Wherein the synchronizer further includes a compression routine; See 11:52-67; 12:1-15.

As to claim 100,

a system installation routine; See Abstract; 11:52-67; 12:1-15;  
a binary difference transaction generator, the binary difference transaction including a binary difference comparison between a first file and a previous version of said first file; See Abstract; 11:52-67; 12:1-15; and  
a network coupling routine; See Abstract; 11:52-67; 12:1-15.

As to claim 101,

wherein the installation routine is determined based on a type of device for which the installation package is intended; See Abstract; 11:52-67; 12:1-15.



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As to claim 102,

wherein the application data access routine includes a file system access routine;

See Abstract; 11:52-67; 12:1-15.

As to claim 106,

on a nonvolatile storage medium; See Abstract; 11:52-67; 12:1-15.

As to claim 107,

wherein the nonvolatile storage medium is a local storage device in a network coupled processing device; See Abstract; 11:52-67; 12:1-15.

As to claim 108,

wherein the nonvolatile storage medium is a network storage server; See Abstract; 11:52-67; 12:1-15.

As to claim 109,

computer code for comparing at least one file on a network coupled device in communication with the network coupled server and extracting binary differencing data representing the difference between the file and a record of the file; See Abstract; 11:52-67; 12:1-15; and

a transaction generator providing at least one transaction including said binary differencing data to an output; See Abstract; 11:52-67; 12:1-15.

As to claim 110,

wherein the record of the file is provided on the network coupled device; See Abstract; 11:52-67; 12:1-15.

As to claim 111,

wherein the record of the file is provided on the network coupled server; See Abstract; 11:52-67; 12:1-15.

As to claim 112,

wherein the record of the file is a previous version in time of the file; See Abstract; 11:52-67; 12:1-15.

As to claim 113

wherein the synchronizer further includes application code to modify a second version of the file by applying said binary differencing data to the second version of the file; See Abstract; 11:52-67; 12:1-15.

As to claim 114,

wherein the second version of the file is on a second network coupled device; See Abstract; 11:52-67; 12:1-15.

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As to claim 115,

wherein the second version of the file is on the network coupled server; See Abstract; 11:52-67; 12:1-15.

As to claim 116,

at least a first binary differencing engine coupled to a first network coupled device; See Abstract; 11:52-67; 12:1-15;

at least a second binary differencing engine coupled to a second network coupled device; See Abstract; 11:52-67; 12:1-15; and

a storage device coupled to the first and the second network coupled devices storing binary differencing data from and outputting binary differencing data to said at least first and second binary differencing engines; See Abstract; 11:52-67; 12:1-15.

As to claim 105,

wherein the installation package is accessible via the World Wide Web; See .

Morris discloses the claimed invention except for wherein the installation package is accessible via the World Wide Web. It would have been obvious to one having ordinary skill in the art at the time the invention was made to provide wherein the installation package is accessible via the World Wide Web that such a modification would enable communicating and loading from anywhere in the world for the internet.

***Allowable Subject Matter***

Claims 84-87 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

***Response to Arguments***

Applicant's arguments filed June 7, 2004 have been fully considered but they are not persuasive.

Applicant's arguments with respect to claims 80-83, 88-104 and 106-116 have been considered but are moot in view of the new ground(s) of rejection.


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**Conclusion**

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Charles Rones whose telephone number is 571-272-4085. The examiner can normally be reached on Monday-Thursday 8am-4pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Dov Popovici can be reached on 571-272-4083. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

  
Charles Rones  
Primary Examiner  
Art Unit 2164

November 16, 2004